

Remarks

After entry of the forgoing amendments, claims 39-49 and 51-63 are pending. Claims 51-53, 55-57 and 61-63 have been amended herein. No claims are canceled or added. Support for the amendments is found at least as set forth in the remarks below. Applicants submit that no new matter has been added with these amendments.

Applicants thank the examiner for withdrawing the objection to claims 39, 40 51-58 and 61-63 for informalities, the § 112, second paragraph rejection denoted "A and B", and the written description rejection under § 112, first paragraph denoted "A, B (with respect to the p variable) and C".

Examiner Interview

Interviews between the Examiner and the undersigned was held August 12, 2008 and September 25, 2008 to discuss the rejections of record. Applicants wish to thank the Examiner for his time and attention to this application.

Rejections under Section 112, First Paragraph

Claims 51-53 and 55-63 stand rejected as containing new matter. Applicants note that the new matter rejection pertained to the recitation of "m = 1-16." Office action, page 3, line 5. However, claims 58, and its dependent claims 59-60, do not reference m at all, or indeed that "m = 1-16." Applicants therefore assume that claims 58-60 are allowable, and request clarification on this issue.

In the interests of advancing prosecution, and without conceding that the rejection has merit, Applicants have amended each of claims 51-53 to recite that "n is 1 to 16 and m is 1, except that one of n or m may be zero." Applicants have also amended each of claims 55-57 and 61-63 to recite that "n is a positive integer from 1 to 16 and m is 1, except that one of them may be zero." Applicants reserve the right to pursue broader claims in a continuing application.

Applicants respectfully submit that there is written description support for the amendment. The fundamental inquiry for determining compliance with the written description requirement is whether the specification conveys with reasonable clarity to those skilled in the art that the inventors had possession of the claimed invention as of the time of filing. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). There is no *in haec verba* requirement for claim limitations. However, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. MPEP 2163.

With respect to claim 51, support is found in the specification, at least as follows:

Formula VIII, required by claim 51 is disclosed at page 9 line 14 to page 10, line 5, wherein m and n, among other variables, are "as defined in the sixth aspect of the invention." At page 8, line 10, under the sixth aspect the invention the specification specifies that "m and n are positive integers, or one of them may be zero." Support is thus explicitly provided for the amendment "one of m or n may be zero." For clarity in claim construction, Applicants have used "except that" rather than "or" preceding this element, to avoid the erroneous interpretation that if one of n or m were zero, the other limitations on n or m would not be required. One of ordinary skill in the art plainly reading the specification would understand that the recitation of "or one of m or n may be zero" is equivalent to "except that one of m or n may be zero," and accordingly that the claimed compounds were described in the specification as filed.

One of ordinary skill in the art would also understand that at the time the application was filed Applicants possessed the claimed compounds in which m is 1, based on the disclosure at page 8, lines 11-12 that "T' is a combinatorial unit, where each T' may be different if m is greater than 1." This conditional statement regarding m inherently contemplates the situation in which m is 1 and a single T' combinatorial unit is provided. In other words, one of ordinary skill in the art would understand that Applicants possessed compounds in which a single T' unit is provided (and therefore that m is 1), because inherent in the disclosure that each T' may be different if m is greater than 1, is a disclosure of m being equal to 1, with a single T' combinatorial unit present.

Moreover, the specification provides explicit support for m being 1. Figures 6 a to c show a reaction scheme for the synthesis of compounds of the sixth aspect of the invention in which m is 1. For example, Figure 6 is described as showing "a reaction scheme for the synthesis of compounds of formula VI and VII." Page 30, lines 9-10. Formula VI is presented as the sixth aspect of the invention, at page 8, lines 5-7. As discussed above, the sixth aspect of the invention is used to define the m and n variables of formula VIII recited in claim 51.

As described in Example 8, at page 69, line 16 to page 73, line 34, Figures 6a, 6b and 6c illustrate reaction schemes for the synthesis of a lysine-glycine dimer, a glycine sublibrary and a PBD- glycine sublibrary, respectively. The end compound synthesized in Example 6c has a single T' combinatorial unit (such that m is 1), with a single peptide bond linking to T". Accordingly, one of ordinary skill in the art would understand that Applicants were in possession of compounds of formula VI in which m is 1 at the time the application was filed,

because the specification clearly sets forth "a reaction scheme for the synthesis of compounds of formula VI" in which m is 1.

Accordingly, claim 51 is supported by the disclosure, both explicitly and inherently.

Each of claims 52, 53, 55-57 and 61-63 describe compounds in which the m and n variables, as for claim 51, are defined directly or ultimately according to the sixth aspect of the invention:

With respect to claim 52, which requires formula XII, m and n, in the twelfth aspect of the invention, are "as defined in the tenth aspect of the invention." Page 11, lines 15-20. The tenth aspect of the invention defines m and n "as ... in the sixth aspect of the invention." Page 10, lines 15-19.

With respect to claim 53, which requires formula XVI, m and n are "as defined in the fourteenth aspect of the invention." Page 13, lines 12-16. The fourteenth aspect of the invention defines m and n "as ... in the sixth aspect of the invention." Page 12, lines 14-18.

With respect to claim 55, which requires formula VI, m and n are defined in the sixth aspect of the invention. Page 8, line 5 to page 9, line 3.

With respect to claim 56, which requires formula X, m and n are "as defined in the sixth aspect of the invention." Page 10, lines 15-19.

With respect to claim 57, which requires formula XIV, m and n are "as defined in the sixth aspect of the invention." Page 12, lines 14-18.

With respect to claim 61, which requires formula VII, m and n are "as defined in the sixth aspect of the invention." Page 9, lines 4-8.

With respect to claim 62, which requires formula XI, m and n are "as defined in the tenth aspect of the invention." Page 11, lines 4-9. The tenth aspect of the invention defines m and n "as ... in the sixth aspect of the invention." Page 10, lines 15-19.

With respect to claim 63, which requires formula XV, m and n are "as defined in the fourteenth aspect of the invention." Page 13, lines 12-16. The fourteenth aspect of the invention defines m and n "as ... in the sixth aspect of the invention." Page 12, lines 14-18.

Accordingly, support for the amendments to claims 52 and 53 to recite that "n is 1 to 16 and m is 1, except that one of n or m may be zero" and to claims 55-57 and 61-63 to recite that "n is a positive integer from 1 to 16 and m is 1, except that one of them may be zero" is

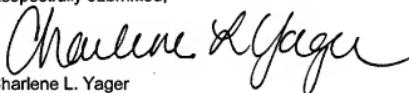
found at least for the same and similar reasons to those set forth above for claim 51, since each of claims 52, 53, 55-57 and 61-63, like claim 51, requires that m and n are defined according to the sixth aspect of the invention and formula VI.

Applicants respectfully submit that amended claims 51-53, 55-57 and 61-63 meet the written description requirement and request that the rejection be withdrawn.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance. Should the examiner feel that any issues remain or wish to discuss anything further, the examiner is invited to contact the undersigned at the number below.

Respectfully submitted,


Charlene L. Yager
Reg. No. 48,887

Docket No.: 065435-9027-US00
Michael Best & Friedrich LLP
One South Pinckney Street
P. O. Box 1806
Madison, WI 53701-1806
(608) 257-3501